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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,995	02/09/2004	Joshua Goodman	MS#306877.01 (5095)	2524
38779 7590 05/29/2009 SENNIGER POWERS LLP (MSFT) 100 NORTH BROADWAY 17TH FLOOR ST. LOUIS, MO 63102				
EXAMINER				
MAL, KEVIN S				
ART UNIT		PAPER NUMBER		
2456				
NOTIFICATION DATE		DELIVERY MODE		
05/29/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

### Office Action Summary

**Application No.**

10/774,995

**Applicant(s)**

GOODMAN, JOSHUA

**Examiner**

KEVIN S. MAI

**Art Unit**

2456

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2008 and 02 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-10,12-17,19-22 and 24-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,12-17,19-22 and 24-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action has been issued in response to Applicant's Amendments filed November 13, 2008 and March 2, 2009.
2. Claims 1, 12, 24, 29 and 36 have been amended. Claims 11 and 23 have been canceled. Claims 1, 2, 4-10, 12-17, 19-22 and 24-40 are pending in the application.

***Response to Arguments***

3. Applicant's arguments filed November 13, 2008 and March 2, 2009 have been fully considered.
4. Applicant's arguments with respect to the 35 U.S.C. 112, first paragraph rejection have been considered but they are not persuasive. Examiner apologizes if the original rejection was unclear however the portion that was not supported was that the stated information was **sent** to the recipient. While the given sections do disclose at least recording the information there are no sections that support sending this information to the recipients. Thus to clarify what is not being taught is sending the stated information to the recipient the only portion the examiner could find about this was in paragraph [0042] wherein it states the communication includes the date and time of the last incoming communication of the recipient.
5. Applicant's arguments with respect to "textually analyzing the communication to be sent and determining whether the analyzed communication complies with the anti-spam rules, laws, and regulations of the identified location of the recipient" have been considered but are moot in

view of the new grounds of rejection. In this argument though applicant points to a feature of Fergusson they felt went against complying with rules and regulations, namely the fact that the system can generate mailing or emails to be sent to the client. However examiner would like to point out claim 8 of the instant application does something similar wherein the system will try to send a communication via a permitted channel if the recipient is on a do-not-send list. Thus this point does not appear to be valid since applicant's own invention has a similar feature used to circumvent the do-not-sent list.

6. Applicant's arguments with respect to the renewal notice of Griebenow have been considered but they are not persuasive. Applicant argues that Griebenow's renewal notice is sent with the condition that the subscription is about to expire. While this may be the case, applicant's claim does not state that the sent communication must be sent without any other given conditions. Thus it is seen that Griebenow can still be applied since its additional sending condition does not prevent it from being used.

7. Other arguments toward claims 2, 4-10, 12-17, 19-22 and 24-40 deal with the issues addressed above and thus for similar reasons those claims remain not allowable.

#### ***Claim Objections***

8. In view of claims 11 and 23 being canceled the pending claim objections have been withdrawn.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1, 12, 24, 29 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant states that paragraph [0042] provides the support for the amendments in claims 1, 12, 24, 29 and 36, however examiner is unable to find the specific areas that support sending “information indicating the type of the incoming communication from the recipient” and “information indicating whether the time between the last time of the incoming communication the present time does not exceed the predetermined time limit” to the recipient. The closest mention of this examiner found in paragraph [0042] was ‘software instructions of server 202 are adapted to include in communication 226 the date and time of the last incoming communication of recipient 206’. If there is another paragraph that provides support for these limitations it is requested that the applicant point them out to the examiner.

11. In view of the amendments made to claims 1, 12, 24, 29 and 36 the pending rejections under 35 U.S.C. 112, second paragraph have been withdrawn.

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 1, 2, 4-11, 24-33 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable U.S. Pub. No. 2003/0212566 A1 to Fergusson et al. (hereinafter “Fergusson”) and further in view of U.S. Pub. No. 2004/0122730 A1 to Tucciarone et al. (hereinafter “Tucciarone”) and US Pub. No. 2005/0210272 to Fotta (hereinafter “Fotta”) and U.S. Pat. No. 5850520 to Griebenow et al. (hereinafter “Griebenow”).

14. **As to Claim 1**, Fergusson discloses **a method for a sender of communications to comply with a predetermined time limit** (Paragraphs [0011] – [0013] of Fergusson disclose determining if a valid prior existing relationship exists with a client by checking if a client has transacted business with the organization within the past year), **said sender having a communication to be sent to a recipient, comprising:**  
**identifying a location of the recipient based on the received incoming communication** (Paragraph [0015] of Fergusson discloses doing a reverse phone number lookup to find the home address of the DNC client);  
**determining if a last time of a prior communication from the recipient is stored in a data store** (Figure 3 discloses checking if a client can be contacted despite being listed on DNC listings. Paragraph [0013] discloses examples of these exemptions include checking if a client has a prior or existing relationship. Thus checking if a client may be contacted would include looking for a last time of prior communication);

**if it is determined that the last time of the prior communication from the client is not stored in the data store, determining if the recipient is on a do-not-spam list according to anti-spam rules, laws and regulations of the identified location of the recipient** (Figure 3

discloses checking to see if the prospective client against government DNC listings as well as internal DNC listings);

**if the recipient is on the do-not-spam list, terminating sending of the communication to the recipient** (Figure 3 discloses if a user is on a DNC list and there exist no reason the client can be contacted despite being listed (for example a prior relationship) then the call will be disallowed) **or sending a separate communication via a compliant channel according to the do-not-spam list** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent

an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws);

**if it is determined that the last time of the prior communication from the recipient is stored in the data store, which indicates a pre-existing relationship exception to the do-not-spam list may apply** (Figure 3 discloses checking if a client can be contacted despite being listed on DNC listings. Paragraph [0013] discloses examples of these exemptions include checking if a client has a prior or existing relationship)

**if it is determined that the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient or if the recipient is not on the do-**

**not-spam list and the last time of the prior communication from the client is not stored in the data store:**

**storing data representing a present time and the identified location corresponding the**

**received incoming communication** (Figure 9 discloses people on a DNC list but with a prior location that stores the location of the recipient. Then since the system determined the recipient has a prior relationship with the company it is seen that the date of last communication is inherently stored in order to make such a determination);

**sending the communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and the present time does not exceed a predetermined time limit, said predetermined time limit being defined and prescribed by the anti-spam rules, laws and regulations of the identified location of the recipient for establishing the preexisting relationship between the recipient and the sender** (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit). As to the time of prior relationship being defined by anti-spam rules, paragraph [0013] of Fergusson discloses because the definition of when a prior or existing relationship exists may differ depending on the state, different parameter values may be set for each of the state DNC listings. Thus it is seen that since the time parameter is changed from state to state, that the time parameter is defined according to each



individuals states DNC laws, which are for establishing preexisting relationships between recipients and senders); **and**

**Fergusson does not explicitly disclose receiving an incoming communication from the recipient of communications, said received incoming communication including at least one of the following types: an electronic mail (e-mail) message, a post mail, an instant messaging message, a chat message, and a website access.**

However, Tucciarone discloses this (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of complying with a predetermined time limit as disclosed by Fergusson with receiving incoming communications from the recipient as disclosed by Tucciarone. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to provide a method of opt-in for the consumers. Tucciarone explains in paragraph [0005] that opt-in email is largely used to generate leads, increase sales, retain, up-sell and cross-sell customers. Thus since opt-in is disclosed to be beneficial to a business it would have been obvious to combine it with Fergusson to further aide the business.

Fergusson does not explicitly disclose textually analyzing the communication to be sent and determining whether the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient; if it is determined that the analyzed communication does not comply with the anti-spam rules, laws and regulations of the identified location of the recipient, terminating sending of the communication to the recipient or sending the communication via a compliant channel according to the do-not-spam list.

However, Fotta discloses analyzing communications for particular information to see if the communications complies with the rules of a regulating authority. Paragraph [0041] of Fotta discloses including in each message an Authenticator that would serve to identify the sending company to the regulating authority. Paragraph [0048] discloses the regulating authority checking for the serial number in each email. Paragraph [0015] discloses this process is done to determine whether to discard or forward the email messages from the company. Thus it is seen that each message is textually analyzed for the Authenticator before it can be sent to the recipient.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the DNC system as disclosed by Fergusson, with analyzing the communication as disclosed by Fotta. One of ordinary skill in the art would have been motivated to combine to certify that a commercial entity is sending messages that abide by the laws and regulations (paragraph [0035] of Fotta).

Fergusson does not explicitly disclose **sending information to the recipient in response to the sent communication**, said information indicating the following: the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and **information enabling the user to confirm the preexisting business relationship between the recipient and the sender defined under the anti-spam rules, laws and regulations** if the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit.

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Further, it is seen that as a renewal notice, it will also include information enabling the user to confirm their relationship (i.e. by renewing their subscription). As to including information about the type of communication they had received from the recipient it is seen that adding such additional information would be obvious)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of complying with a predetermined time limit as disclosed by Fergusson with informing the consumer of their last time of communication as disclosed by Griebenow. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to prevent the relationship between the business and the consumer from ending. Griebenow explains in column 8 lines 30 – 50 that renewals are sent if a

consumers subscription is about to lapse, this is done to prevent the termination of the subscription. Similarly, contact would be made to the consumer in Fergusson's invention to encourage a response such that future communications would remain DNC complaint, and thus prevent the termination of their business relationship.

15. **As to Claim 2**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 1, **wherein the incoming communication is received via one or more of the following: a direct communication, a postal mail, a data communication network, or a telephonic communication network** (Paragraphs [0011] – [0015] of Fergusson disclose telemarketing which implies telephonic communications, mailing to home addresses which is postal mail, and e-mailing which is seen as data communication).

16. **As to Claim 4**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 1, **wherein said sending comprises sending the communication to the recipient if the stored data indicates that the present time is within a range prior to expiration of the predetermined time limit, said communication for inducing said recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as

contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

17. **As to Claim 5**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 1, **wherein if the time between the last time that the incoming communication is received and the present time exceeds the predetermined time limit, the communication is sent to the recipient via a channel permitted by a rule, law, or regulation that prescribes the predetermined time limit** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

18. **As to Claim 6**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 1, **further comprising:**  
**storing a list of recipients whose last time of incoming communications to the sender cannot be identified** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list, this is read to be the list of people who do not have a prior relationship with the company and thus their last time of communication cannot be identified);  
**and**

**wherein said sending the communication comprises sending the communication to the recipient if the recipient is included in said list of recipients, said communication for inducing the recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

19. **As to Claim 7**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 6, **further comprising removing the recipient from said list of recipients after the recipient has sent another incoming communication to the sender** (Paragraph [0084] of Fergusson discloses a “On DNC List But With Prior Or Existing Relationship” list, a “On DNC List Without Prior Or Existing Relationship” list, and a “Free to Call” list. The existence of each of these lists implies that clients whose calling status changes will be moved to an appropriate list. As such in the situation where a client on the DNC list was contacted and business was transacted it is likely the case that the client would then be moved to a more appropriate list reflecting the new relationship).

20. **As to Claim 8**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 1, **further comprising:**

**storing a list of recipients who are included in a do-not-send list** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list where the names of prospective clients who fall under that category reside);

**identifying if the recipient is included in said list of recipients** (Paragraphs [0091] – [0094] of Fergusson disclose a representative contacting a client through channels other than the telephone in order comply with DNC laws. This action would inherently include identifying if their intended client is on the DNC list otherwise such an action to comply with the DNC laws would not be taken); **and**

**wherein said sending the communication comprises sending the communication to the recipient via a permitted channel if the recipient is included in said list of recipients** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

21. **As to Claim 9**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 8, **wherein said sending further comprises sending the communication to the recipient via any channel if the recipient is included in said list of recipients and the time between the last time that the incoming communication is received and the present time does not exceed the predetermined time limit** (Paragraphs [0011] – [0012] of Fergusson disclose that if an existing relationship exists between the company and

client (read to be the same as not exceeding the time limit as explained in paragraph [0012]) the telemarketer is free to contact the identified DNC client despite being on the DNC list).

22. **As to Claim 10**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 1, **wherein the sender is a group** (Paragraph [0022] of Tucciarone discloses the system matches the requests of users (clients) with information inventory of multiple suppliers (read to be a group of senders)), **wherein said incoming communication from the recipient is received by one of the group** (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication)), **wherein said storing comprises storing data indicating the last time that the incoming communication is received by said one of the group** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database), **and wherein said sending comprises sending the communication from said one of the group to the recipient if the time between the last time that the incoming communication is received by said one of the group and the present time does not exceed the predetermined time limit** (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the



length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 1 as disclosed by Fergusson-Tucciarone-Griebenow, with making the sender a group as disclosed by Tucciarone. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to (paragraphs [0014] – [0020] of Tucciarone) give clients easier access to more information and so allow for a simple and easy way to receive services from multiple suppliers.

23. **As to Claim 24**, Fergusson discloses **a system for a sender of communications to comply with a predetermined time limit, said sender having a communication to be sent to a recipient, comprising:**

**a memory area adapted to store data indicating a last time that an incoming communication from the recipient is received by the sender, said stored data of the incoming communication indicating a location of the recipient based on the received incoming communication, said stored incoming communication including at least one of the following types: an electronic mail (e-mail) message, a post mail, an instant messaging message, a chat message, and a website access** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database. Also the database itself serves as the memory area mentioned in the claim. As to the data also including the location of the recipient,

paragraph [0016] of Fergusson discloses a new account worksheet for keeping information such as the state of residence of the client. Then goes to say the information on the worksheet will be stored for at least the time period prescribed by appropriate DNC laws); and

**a device adapted to perform the following:**

**based on the stored data indicating the last time in the memory area, which indicates a pre-existing relationship exception to the do-not-spam list may apply** (Figure 3 discloses checking if a client can be contacted despite being listed on DNC listings. Paragraph [0013] discloses examples of these exemptions include checking if a client has a prior or existing relationship);

**if it is determined that the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient,**

**send the communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed the predetermined time limit, said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient for establishing a preexisting relationship between the recipient and the sender** (Paragraph [0015] of Fergusson discloses the system may help generate a mailing or e-mail that can be send to the prospective client. Then in paragraphs [0011] – [0013] it is disclosed that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit). As to the time limit

being defined by rules of the location, paragraph [0013] of Fergusson discloses because the definition of when a prior or existing relationship exists may differ depending on the state, different parameter values may be set for each of the state DNC listings. Thus it is seen that since the time parameter is changed from state to state, that the time parameter is defined according to each individuals states DNC laws, which are for establishing preexisting relationships between recipients and senders); and

Fergusson does not explicitly disclose receiving an incoming communication.

Tucciarone discloses this (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone).

Examiner recites the same rationale to combine used in claim 1.

Fergusson does not explicitly disclose **textually analyze the communication to be sent to the recipient;**  
**determine whether the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient;**  
**if it is determined that the analyzed communication does not comply with the anti-spam rules, laws and regulations of the identified location of the recipient, terminate sending of**

**the communication to the recipient or send the communication via a compliant channel according to the do-not-spam list;**

However, Fotta discloses analyzing communications for particular information to see if the communications complies with the rules of a regulating authority. Paragraph [0041] of Fotta discloses including in each message an Authenticator that would serve to identify the sending company to the regulating authority. Paragraph [0048] discloses the regulating authority checking for the serial number in each email. Paragraph [0015] discloses this process is done to determine whether to discard or forward the email messages from the company. Thus it is seen that each message is textually analyzed for the Authenticator before it can be sent to the recipient.

Examiner recites the same rationale to combine used in claim 1.

Fergusson does not explicitly disclose **wherein the device sends information to the recipient in response to the sent communication**, said information indicating the following: **the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and information enabling the recipient to confirm the preexisting business relationship between the recipient and the sender defined under the anti-spam rules, laws and regulations if the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit**

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's

subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Further, it is seen that as a renewal notice, it will also include information enabling the user to confirm their relationship (i.e. by renewing their subscription). As to including information about the type of communication they had received from the recipient it is seen that adding such additional information would be obvious)

Examiner recites the same rationale to combine used in claim 1.

24. **As to Claim 25**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 24, **wherein said device is a telephonic device, a server, or a client** (Paragraph [0015] of Fergusson discloses contacting clients at home via the phone which implies a telephonic device and also generating e-mails which implies a server/client type system).

25. **As to Claim 26**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 24, **wherein the device is adapted to send the communication to the recipient if the stored data indicates that the present time is within a range prior to expiration of the predetermined time limit, said communication for inducing said recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as

contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

26. **As to Claim 27**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 24, **wherein the memory area is adapted to store a list of recipients whose last time of incoming communications to the sender cannot be identified** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship.” This is read to be the list of people who do not have a prior relationship with the company and thus their last time of communication cannot be identified. Where the existence of this list implies a memory area to store it in), **wherein the device is adapted to send the communication to the recipient if the recipient is included in said list of recipients, said communication for inducing the recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future), **and further comprising computer-executable instructions to remove the recipient from said list of recipients after the recipient has sent another incoming communication to the sender** (Paragraph [0084] of Fergusson discloses a “On DNC List But With Prior Or Existing Relationship” list, a “On DNC List Without Prior Or Existing Relationship” list, and a “Free to Call” list. The existence of each of these lists implies that

clients whose calling status changes will be moved to an appropriate list. As such in the situation where a client on the DNC list was contacted and business was transacted it is likely the case that the client would then be moved to a more appropriate list reflecting the new relationship. In Figure 9 these lists are shown on a webpage, which implies a backend containing instructions to support the lists).

27. **As to Claim 28**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 24, **wherein the sender is a group** (Paragraph [0022] of Tucciarone discloses the system matches the requests of users (clients) with information inventory of multiple suppliers (read to be a group of senders)), **wherein the memory area is adapted to store data indicating the last time that the incoming communication from the recipient is received by one of the group** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database. Also the database itself serves as the memory area mentioned in the claim), **and wherein the device is adapted to send the communication from said one of the group to the recipient if the time between the last time that the incoming communication is received by said one of the group and the present time does not exceed the predetermined time limit** (Paragraph [0015] of Fergusson discloses the system may help generate a mailing or e-mail that can be send to the prospective client. Then in paragraphs [0011] – [0013] it is disclosed that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a

communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

Examiner recites the same rationale to combine used in claim 10.

28. **As to Claim 29**, Fergusson discloses a **system for a sender of communications to comply with a rule, law, or regulation, said sender having a communication to be sent to a recipient, comprising:**

**computer-executable instructions** (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients and be contacted and still maintain DNC compliance. This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention) **to identify a location of a recipient based on an incoming communication received from the recipient** (Paragraph [0015] of Fergusson discloses doing a reverse phone number lookup to find the home address of the DNC client),

**a memory area adapted to store data indicating the identified location of the recipient** (Paragraph [0016] of Fergusson discloses a new account worksheet for keeping information such as the state of residence of the client. Then goes to say the information on the worksheet will be stored for at least the time period prescribed by appropriate DNC laws. This implies the existence of a memory area to store the data else the data could not be stored);

**computer-executable instructions to determine if a last time of a prior communication from the recipient is stored in the memory area** (Figure 3 discloses checking if a client can be



contacted despite being listed on DNC listings. Paragraph [0013] discloses examples of these exemptions include checking if a client has a prior or existing relationship. Thus checking if a client may be contacted would include looking for a last time of prior communication);

**if it is determined that the last time is not stored in the memory area, computer-executable instructions to determine if the recipient is on a do-not-spam list according to anti-spam rules, laws and regulations of the identified location of the recipient** (Figure 3 discloses checking to see if the prospective client against government DNC listings as well as internal DNC listings);

**if the recipient is on the do-not-spam list, computer-executable instructions to terminate sending of the communication to the recipient** (Figure 3 discloses if a user is on a DNC list and there exist no reason the client can be contacted despite being listed (for example a prior relationship) then the call will be disallowed) **or computer-executable instructions to send a separate communication via a compliant channel according to the do-not-spam list** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws);

**if it is determined that the last time of the prior communication from the recipient is stored in the memory area, which indicates a pre-existing relationship exception to the do-not-spam list may apply** (Figure 3 discloses checking if a client can be contacted despite being

listed on DNC listings. Paragraph [0013] discloses examples of these exemptions include checking if a client has a prior or existing relationship);

**if it is determined that the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient or if the recipient is not on the do-not-spam list and the last time of the prior communication from the client is not stored in the memory area;**

**computer-executable instructions to store data indicating a present time and the identified location corresponding the received incoming communication** (Figure 9 discloses people on a

DNC list but with a prior location that stores the location of the recipient. Then since the system determined the recipient has a prior relationship with the company it is seen that the date of last communication is inherently stored in order to make such a determination);

**computer-executable instructions to send a communication to the recipient, said communication indicating if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed a predetermined time limit, said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient for establishing a preexisting relationship between the recipient and the sender** (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit). As to the time of prior relationship being defined by anti-spam

rules, paragraph [0013] of Fergusson discloses because the definition of when a prior or existing relationship exists may differ depending on the state, different parameter values may be set for each of the state DNC listings. Thus it is seen that since the time parameter is changed from state to state, that the time parameter is defined according to each individuals states DNC laws, which are for establishing preexisting relationships between recipients and senders); **and**

Fergusson does not explicitly disclose **said received incoming communication including at least one of the following types: an electronic mail (e-mail) message, a post mail, an instant messaging message, a chat message, and a website access;**

However, Tucciarone discloses this (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone).

Examiner recites the same rationale to combine used in claim 1.

Fergusson does not explicitly disclose **computer-executable instructions to textually analyze the communication to be sent and computer-executable instructions to determine whether the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient;**

**if it is determined that the analyzed communication does not comply with the anti-spam rules, laws and regulations of the identified location of the recipient, computer- executable instructions to terminate sending of the communication to the recipient or computer-executable instructions to send the communication via a compliant channel according to the do- not-spam list;**

However, Fotta discloses analyzing communications for particular information to see if the communications complies with the rules of a regulating authority. Paragraph [0041] of Fotta discloses including in each message an Authenticator that would serve to identify the sending company to the regulating authority. Paragraph [0048] discloses the regulating authority checking for the serial number in each email. Paragraph [0015] discloses this process is done to determine whether to discard or forward the email messages from the company. Thus it is seen that each message is textually analyzed for the Authenticator before it can be sent to the recipient.

Examiner recites the same rationale to combine used in claim 1.

Fergusson does not explicitly disclose **a first device adapted to send information to the recipient in response to the sent communication**, said information indicating the following: the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, **and information enabling the recipient to confirm the preexisting business relationship between the recipient and the sender defined under the anti-spam rules, laws and regulations** if the time

**between the last time of the incoming communication and the present time does not exceed the predetermined time limit**

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Further, it is seen that as a renewal notice, it will also include information enabling the user to confirm their relationship (i.e. by renewing their subscription). As to including information about the type of communication they had received from the recipient it is seen that adding such additional information would be obvious)

Examiner recites the same rationale to combine used in claim 1.

29. **As to Claim 30**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 29, **wherein said computer-executable instructions to determine if the communication complies with the rule, law or regulation comprises electronic mail client instructions** (Paragraph [0015] of Fergusson discloses that in one embodiment the system may generate an e-mail that can be sent to a client. Since the system that determines rule compliance also e-mails it can be viewed that an e-mail client is performing the rule compliance determination. Further since the system that does the determination of compliance was shown above to use computer instructions it is implied that the electronic mail client would also be supported similarly).

30. **As to Claim 31**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 29, **wherein the location of the recipient is identified based on a postal address if the postal address is provided with the incoming communication, wherein the location of the recipient is identified based on an internet protocol address, server location, or domain name of the recipient if the incoming communication is received via a data communication network, and wherein the location of the recipient is identified based on a telephonic address of the recipient if the incoming communication is received via a telephonic communication network** (Paragraph [0091] of Fergusson discloses that in some cases limited information known about a client can be provided to one or more databases to return additional contact information. In one scenario the home address of the client is gotten by a reverse phone number lookup database. Similarly the other methods (mail/e-mail) could be handled by a similar method to find the location of the client).

31. **As to Claim 32**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 29, **wherein the first device is adapted to send the communication to the recipient via a channel permitted by the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

32. **As to Claim 33**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 32, **further comprising: computer-executable instructions to receive an input from the sender, said input indicating whether the communication complies with the rule, law, or regulation** (Paragraph [0115] of Fergusson discloses a supervisor controls window that allows a compliance supervisor to set selected parameter values for states. For example the supervisor can set the level of what defines a states prior existing relationship. This is seen to be the same as the sender sending an input indicating compliance with rules. The control window mentioned is shown in Figure 13 to be a website, which implies a backend containing instructions to support control window); **and wherein the first device is adapted to send the communication to the recipient via any channel if the received input indicates that the communication complies with the rule, law, or regulation** (Paragraphs [0011] – [0012] of Fergusson disclose that if an existing relationship exists between the company and client (read to be the same as not exceeding the time limit as explained in paragraph [0012]) the telemarketer is free to contact the identified DNC client despite being on the DNC list).

33. **As to Claim 36**, Fergusson discloses **one or more computer storage media having computer- executable components for a sender of communications to comply with a predetermined time limit, said sender having a communication to be sent to a recipient, said computer readable storage media comprising:**

**a storage component for storing data indicating a last time that the incoming communication is received by the sender, said stored data of the incoming communication indicating a location of the recipient based on the received incoming communication**

(Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database. Also the database itself serves as the memory area mentioned in the claim. As to the data also including the location of the recipient, paragraph [0016] of Fergusson discloses a new account worksheet for keeping information such as the state of residence of the client. Then goes to say the information on the worksheet will be stored for at least the time period prescribed by appropriate DNC laws); **and**

**wherein the storage component performs the following:**

**determine if a last time of an earlier communication from the recipient is stored in storage component** (Figure 3 discloses checking if a client can be contacted despite being listed on DNC listings. Paragraph [0013] discloses examples of these exemptions include checking if a client has a prior or existing relationship. Thus checking if a client may be contacted would include looking for a last time of prior communication);

**if it is determined that the last time is not stored in the storage component, determine if the recipient is on a do-not-spam list according to anti-spam rules, laws and regulations of the identified location of the recipient** (Figure 3 discloses checking to see if the prospective client against government DNC listings as well as internal DNC listings);



**if the recipient is on the do-not-spam list, terminate sending of the communication to the recipient** (Figure 3 discloses if a user is on a DNC list and there exist no reason the client can be contacted despite being listed (for example a prior relationship) then the call will be disallowed)**or send a separate communication via a compliant channel according to the do-not-spam list** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws);

**if it is determined that the last time of the prior communication from the recipient is stored in the storage component, which indicates a pre-existing relationship exception to the do-not-spam list may apply** (Figure 3 discloses checking if a client can be contacted despite being listed on DNC listings. Paragraph [0013] discloses examples of these exemptions include checking if a client has a prior or existing relationship);

**if it is determined that the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient or if the recipient is not on the do-not-spam list and the last time of the prior communication from the client is not stored in the storage component:**

**store data indicating a present time and the identified location corresponding the received incoming communication** (Figure 9 discloses people on a DNC list but with a prior location that stores the location of the recipient. Then since the system determined the recipient has a prior

relationship with the company it is seen that the date of last communication is inherently stored in order to make such a determination);

**a sending component for sending a communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed the predetermined time limit, said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient for establishing a preexisting relationship between the recipient and the sender** (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit). As to the time of prior relationship being defined by anti-spam rules, paragraph [0013] of Fergusson discloses because the definition of when a prior or existing relationship exists may differ depending on the state, different parameter values may be set for each of the state DNC listings. Thus it is seen that since the time parameter is changed from state to state, that the time parameter is defined according to each individuals states DNC laws, which are for establishing preexisting relationships between recipients and senders); **and**

Fergusson does not explicitly disclose **a receiving component for receiving an incoming communication from a recipient of communications, said received incoming**

**communication including at least one of the following types: an electronic mail (e-mail) message, a post mail, an instant messaging message, a chat message, and a website access;**

However, Tucciarone discloses this (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone)

Examiner recites the same rationale to combine used in claim 1.

Fergusson does not explicitly disclose **textually analyze the communication to be sent and determine whether the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient; if it is determined that the analyzed communication does not comply with the anti-spam rules, laws and regulations of the identified location of the recipient, terminate sending of the communication to the recipient or send the communication via a compliant channel according to the do-not-spam list;**

However, Fotta discloses analyzing communications for particular information to see if the communications complies with the rules of a regulating authority. Paragraph [0041] of Fotta discloses including in each message an Authenticator that would serve to identify the sending company to the regulating authority. Paragraph [0048] discloses the regulating authority checking for the serial number in each email. Paragraph [0015] discloses this process is done to

determine whether to discard or forward the email messages from the company. Thus it is seen that each message is textually analyzed for the Authenticator before it can be sent to the recipient.

Examiner recites the same rationale to combine used in claim 1.

Fergusson does not explicitly disclose **wherein the sending component sends information to the recipient in response to the sent communication, said information indicating the following: the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and information enabling the recipient to confirm the preexisting business relationship between the recipient and the sender defined under the anti-spam rules, laws and regulations if the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit**

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Further, it is seen that as a renewal notice, it will also include information enabling the user to confirm their relationship (i.e. by renewing their subscription). As to including information about the type of communication they had received from the recipient it is seen that adding such additional information would be obvious)

Examiner recites the same rationale to combine used in claim 1.

34. **As to Claim 37**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 36, **wherein the sending component sends the communication to the recipient if the stored data indicates that the present time is within a range prior to expiration of the predetermined time limit, said communication for inducing said recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

35. **As to Claim 38**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 36, **wherein the storage component stores a list of recipients whose last time of incoming communications to the sender cannot be identified** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list This is read to be the list of people who do not have a prior relationship with the company and thus their last time of communication cannot be identified), **and wherein the sending component sends the communication to the recipient if the recipient is included in said list of recipients, said communication for inducing the recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to

establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

36. **As to Claim 39**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 36, **wherein the storage component stores a list of recipients who are included in a do-not-send list** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list where the names of prospective clients who fall under that category reside), **and wherein the sending component sends the communication to the recipient via a permitted channel if the recipient is included in said list of recipients** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

37. **As to Claim 40**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 36. Fergusson-Tucciarone-Griebenow do not explicitly disclose **wherein the sender is a group** (Paragraph [0022] of Tucciarone discloses the system matches the requests of users (clients) with information inventory of multiple suppliers (read to be a group of senders)), **wherein said incoming communication from the recipient is received by**

**one of the group** (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication)). Ferguson discloses **wherein the storage component stores data indicating the last time that the incoming communication is received by said one of the group** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database), **and wherein the sending component sends the communication from said one of the group to the recipient if the time between the last time that the incoming communication is received by said one of the group and the present time does not exceed the predetermined time limit** (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

Examiner recites the same rationale to combine used in claim 10.

38. Claims 12-17, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson-Tucciarone-Fotta-Griebenow and further in view of U.S. Pub. No. 2004/0128321 A1 to Hamer (hereinafter “Hamer”).

39. As to Claim 12, Fergusson discloses a method for a sender of communications to comply with a rule, law, or regulation, said sender having a communication to be sent to a recipient, comprising:

**identifying a location of the recipient based on the received incoming communication**

(Paragraph [0015] of Fergusson discloses doing a reverse phone number lookup to find the home address of the DNC client);

**determining if a last time of an earlier communication from the recipient is stored in a data store** (Figure 3 discloses checking if a client can be contacted despite being listed on DNC

listings. Paragraph [0013] discloses examples of these exemptions include checking if a client has a prior or existing relationship. Thus checking if a client may be contacted would include looking for a last time of prior communication);

**if it is determined that the last time is not stored in the data store, determining if the recipient is on a do-not-spam list according to anti-spam rules, laws and regulations of the identified location of the recipient** (Figure 3 discloses checking to see if the prospective client against government DNC listings as well as internal DNC listings);

**if the recipient is on the do-not-spam list, terminating sending of the communication to the recipient** (Figure 3 discloses if a user is on a DNC list and there exist no reason the client can be contacted despite being listed (for example a prior relationship) then the call will be disallowed) **or sending a separate communication via a compliant channel according to the do-not-spam list** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters



or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws);

**if it is determined that the last time of the prior communication from the recipient is stored in the data store, which indicates a pre-existing relationship exception to the do-not-spam**

**list may apply** (Figure 3 discloses checking if a client can be contacted despite being listed on DNC listings. Paragraph [0013] discloses examples of these exemptions include checking if a client has a prior or existing relationship

**if it is determined that the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient or if the recipient is not on the do-not-spam list and the last time of the prior communication from the client is not stored in the data store;**

**storing data indicating a present time and the identified location corresponding the received incoming communication** (Figure 9 discloses people on a DNC list but with a prior

location that stores the location of the recipient. Then since the system determined the recipient has a prior relationship with the company it is seen that the date of last communication is inherently stored in order to make such a determination);

**determining if the communication complies with a rule, law, or regulation of the identified location of the recipient, said communication indicating if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed a predetermined time limit, said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient for establishing the preexisting relationship between the recipient**

**and the sender** (Paragraph [0088] of Fergusson discloses that some clients listed on an “On DNC List But With Prior Or Existing Relationship” list can be contacted and others cannot. It then cites an example of one client being in Minnesota and able to be contacted and another client in Indiana who cannot be contacted despite both of them being on the list. This is explained to be because the definition of a relationship is different for each state. Given this example and the listing to support it, it is implied that Fergusson’s invention would check to see if a call would comply with rules of the clients location. As to the rule being determined by the location, it is seen above that there are different scenarios for Indiana and Minnesota. Then as to it being a pre-determined time limit paragraph [0013] of Fergusson discloses a prior relationship may be determined by if a client transacted business with the organization within the past year. Where the past year is further explained to be definable based on the different states DNC laws, which are for establishing preexisting relationships between recipients and senders);

Fergusson does not explicitly disclose **receiving an incoming communication from the recipient of communications, said received incoming communication including at least one of the following types: an electronic mail (e-mail) message, a post mail, an instant messaging message, a chat message, and a website access;**

However, Tucciarone discloses this (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that

the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone).

Examiner recites the same rationale to combine used in claim 1.

Fergusson does not explicitly disclose **textually analyzing the communication to be sent and determining whether the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient; if it is determined that the analyzed communication does not comply with the anti-spam rules, laws and regulations of the identified location of the recipient, terminating sending of the communication to the recipient or sending the communication via a compliant channel according to the do-not-spam list;**

However, Fotta discloses analyzing communications for particular information to see if the communications complies with the rules of a regulating authority. Paragraph [0041] of Fotta discloses including in each message an Authenticator that would serve to identify the sending company to the regulating authority. Paragraph [0048] discloses the regulating authority checking for the serial number in each email. Paragraph [0015] discloses this process is done to determine whether to discard or forward the email messages from the company. Thus it is seen that each message is textually analyzed for the Authenticator before it can be sent to the recipient.

Examiner recites the same rationale to combine used in claim 1.

Fergusson does not explicitly disclose **sending information to the recipient, said information indicating of the following: the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and information enabling the recipient to confirm the preexisting business relationship between the recipient and the sender defined under the anti-spam rules, laws and regulations if the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit; and**

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Further, it is seen that as a renewal notice, it will also include information enabling the user to confirm their relationship (i.e. by renewing their subscription). As to including information about the type of communication they had received from the recipient it is seen that adding such additional information would be obvious)

Examiner recites the same rationale to combine used in claim 1.

Fergusson does not explicitly disclose **sending the communication to the recipient, wherein if multiple locations of the recipient are identified, the location of the recipient is the location having the most restrictive rule law, or regulation among the identified multiple locations.**

However, Hamer discloses this (Paragraphs [0056] – [0059] of Hamer disclose a rule engine that selects which rules to follow based on specific criteria. It further explains that in the case where more than one rule set is applicable the engine locates the primary rule set by finding the highest-ranking rule set with the most restrictive action value. In Fergusson it was disclosed that a supervisor could set the various rules associated with the different states (seen to be the same as having more than one applicable rule set). Thus when the rule engine is combined with the rule sets of the various states it can be seen that the same idea is disclosed. Namely Hamer discloses both the idea of having multiple locations associated with one recipient (having more than one rule set applicable) as well as selecting the most restrictive action (finding the highest-ranking rule set).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of verifying DNC compliance as disclosed by Fergusson, with the rule engine as disclosed by Hamer. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to comply with DNC laws. As disclosed by Fergusson the entire invention pertains to preventing a company from unintentionally breaking laws dealing with DNC lists. As such it would be obvious in the scenario where a client is potentially affected by two laws to choose the more restrictive one. For if the company complies with the more restrictive rule set there is no way the company can accidentally break the law in either state. If, however, the company chose the more lenient rule set there would be the potential for breaking the law in the other state. Thus it would be obvious to implement the rule engine feature in the scenario where a client is based in more than one state.

40. **As to Claim 13**, Fergusson-Tucciarone-Fotta-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein said determining if the communication complies with the rule, law, or regulation of the identified location of the recipient comprises determining if the communication complies with the rule, law, or regulation via textual analysis of the communication** (Paragraphs [0091] – [0093] of Fergusson disclose an embodiment where the communication can be done via e-mail or mail instead. In these situations because they are inherently text it would be obvious that any analysis done on them would be textual analysis. Thus it is seen that determination of compliance for this embodiment would inherently use textual analysis).

41. **As to Claim 14**, Fergusson-Tucciarone-Fotta-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein said determining if the communication complies with the rule, law, or regulation is performed in an electronic mail client** (Paragraph [0015] of Fergusson discloses that in one embodiment the system may generate an e-mail that can be sent to a client. Since the system that determines rule compliance also e-mails it can be viewed that an e-mail client is performing the rule compliance determination).

42. **As to Claim 15**, Fergusson-Tucciarone-Fotta-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein said sending the communication comprises sending the communication to the recipient via a channel permitted by the rule, law, or regulation of the identified location of the recipient if the communication is determined not**

**to comply with the rule, law, or regulation** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

43. **As to Claim 16**, Fergusson-Tucciarone-Fotta-Griebenow-Hamer discloses the invention as claimed as described in claim 15, **further comprising:**

**receiving an input from the sender, said input indicating whether the communication complies with the rule, law, or regulation** (Paragraph [0115] of Fergusson discloses a supervisor controls window that allows a compliance supervisor to set selected parameter values for states. For example the supervisor can set the level of what defines a states prior existing relationship. This is seen to be the same as the sender sending an input indicating compliance with rules); **and**

**wherein said sending the communication comprises sending the communication to the recipient via any channel if the received input indicates that the communication complies with the rule, law, or regulation** (Paragraphs [0011] – [0012] of Fergusson disclose that if an existing relationship exists between the company and client (read to be the same as not exceeding the time limit as explained in paragraph [0012]) the telemarketer is free to contact the identified DNC client despite being on the DNC list).

44. **As to Claim 17**, Fergusson-Tucciarone-Fotta-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein the location of the recipient is identified based on a postal address if the postal address is provided with the incoming communication, wherein the location of the recipient is identified based on an internet protocol address, server location, or domain name of the recipient if the incoming communication is received via a data communication network, and wherein the location of the recipient is identified based on a telephonic address of the recipient if the incoming communication is received via a telephonic communication network** (Paragraph [0091] of Fergusson discloses that in some cases limited information known about a client can be provided to one or more databases to return additional contact information. In one scenario the home address of the client is gotten by a reverse phone number lookup database. Similarly the other methods (mail/e-mail) could be handled by a similar method to find the location of the client).

45. **As to Claim 19**, Fergusson-Tucciarone-Fotta-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein the location of the recipient is a location having the most restrictive rule, law, or regulation if the location of the recipient cannot be identified** (Paragraphs [0056] – [0059] of Hamer disclose a rule engine that selects which rules to follow based on specific criteria. It further explains that in the case where more than one rule set is applicable the engine locates the primary rule set by finding the highest-ranking rule set with the most restrictive action value. In Fergusson it was disclosed that a supervisor could set the various rules associated with the different states (seen to be the same as having more than one applicable rule set). Thus when the rule engine is combined with the rule sets of the various



states it can be seen that the same idea is disclosed. Namely Hamer discloses both the idea of having multiple locations associated with one recipient (having more than one rule set applicable) as well as selecting the most restrictive action (finding the highest-ranking rule set).

Examiner recites the same rationale to combine used in claim 12.

46. Claims 20, 21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson-Tucciarone-Fotta-Griebenow-Hamer and further in view of U.S. Pub. No. 2004/0017899 A1 to Garfinkel et al. (hereinafter "Garfinkel").

47. **As to Claim 20**, Fergusson-Tucciarone-Fotta-Griebenow-Hamer discloses the invention as claimed as described in claim 12. Fergusson-Tucciarone-Fotta-Griebenow-Hamer does not explicitly disclose **wherein said sending the communication to the recipient comprises: effecting compliance of the communication with the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation; and sending the compliant communication to the recipient.**

However, Garfinkel discloses this (Abstract of Garfinkel discloses determining if a call requires caller ID information and then if it is determined that caller ID information is required the system will provide a predetermined called ID information packet with the call. Otherwise if the call is determined to not require caller ID information the system will allow the call to continue freely. Then as to sending the complaint communication, paragraph [0011] of Garfinkel discloses then routing the call to its final destination)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 12 as disclosed by Fergusson-Tucciarone-Fotta-Griabenow-Hamer, with effecting compliance on a communication as disclosed by Garfinkel. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to (paragraph [0003] of Garfinkel) assure compliance with Federal and State Caller ID transmission rules. In the case of e-mail it would be similarly beneficial to add compliance to adhere to DNC rules.

48. **As to Claim 21**, Fergusson-Tucciarone-Fotta-Griabenow-Hamer-Garfinkel discloses the invention as claimed as described in claim 20, **wherein said effecting compliance of the communication comprises including one or more of the following information in the communication if required by the rule, law, or regulation of the identified location of the recipient: a labeling that the communication is unsolicited, an address of the sender, a phone number of the sender, or unsubscription information** (Abstract of Garfinkel discloses determining if a call requires caller ID information and then if it is determined that caller ID information is required the system will provide a predetermined called ID information packet with the call. Otherwise if the call is determined to not require caller ID information the system will allow the call to continue freely).

Examiner recites the same rationale to combine used in claim 20.

49. **As to Claim 34**, Fergusson-Tucciarone-Fotta-Griabenow discloses the invention as claimed as described in claim 29. Fergusson-Tucciarone-Fotta-Griabenow does not explicitly

disclose **further comprising computer-executable instructions to effect compliance of the communication with the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation, and wherein the first device is adapted to send the compliant communication to the recipient.**

However, Garfinkel discloses this (Abstract of Garfinkel discloses determining if a call requires caller ID information and then if it is determined that caller ID information is required the system will provide a predetermined called ID information packet with the call. Otherwise if the call is determined to not require caller ID information the system will allow the call to continue freely. Then as to sending the complaint communication, paragraph [0011] of Garfinkel discloses then routing the call to its final destination)

Examiner recites the same rationale to combine used in claim 20.

50. Claims 22 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson-Tucciarone-Fotta-Griebenow-Hamer and further in view of U.S. Pat. No. 7155608 B1 to Malik et al. (hereinafter "Malik").

51. **As to Claim 22**, Fergusson-Tucciarone-Fotta-Griebenow-Hamer discloses the invention as claimed as described in claim 12. Fergusson-Tucciarone-Fotta-Griebenow-Hamer does not explicitly disclose **further comprising using a first computer having a first internet protocol address or domain to send the communication to the recipient if the communication is determined to comply with the rule, law, or regulation of the identified location of the recipient and using a second computer having a second internet protocol address or**

**domain different from the first internet protocol address or domain to send the communication to the recipient if the communication is determined not to comply with the rule, law, or regulation of the identified location of the recipient.**

However, Malik discloses this (Column 1 lines 30 – 67 and Column 2 lines 1 – 30 of Malik disclose that a current method employed by spammers is to use a different IP address in case their current one gets blocked. This is seen to be implementing the same idea as the applicant's invention. The first computer exists to take care of compliant e-mail and the second computer exists to send out e-mail that is not compliant. Similarly Malik describes a system where a spammer will mail out from one IP until that IP is blocked and then begin to mail from another IP. The essential thing being that when the circumstances change, they both change IP's to circumvent the current problem).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 12 as taught by Fergusson-Tucciarone-Fotta-Griebenow-Hamer, with changing IP addresses to bypass the situation as taught by Malik. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to further extend the idea of circumventing the DNC laws. Fergusson teaches using other methods such as e-mail or snail mail to circumvent not being able to call the DNC numbers. Had a rule existed such that the telemarketer could simply use a different phone line and still be within DNC compliance it would have been obvious to add such a feature to the invention disclosed in Fergusson.

52. **As to Claim 35**, Fergusson-Tucciarone-Fotta-Griebenow discloses the invention as claimed as described in claim 29. Fergusson-Tucciarone-Fotta-Griebenow does not explicitly disclose **further comprising: a second device having a second internet protocol address or domain and adapted to send the communication to the recipient if the communication is determined not to comply with the rule, law, or regulation of the identified location of the recipient; and wherein the first device has a first internet protocol address or domain different from the second internet protocol address or domain and is adapted to send the communication to the recipient if the communication is determined to comply with the rule, law, or regulation of the identified location of the recipient.**

However, Malik discloses this (Column 1 lines 30 – 67 and Column 2 lines 1 – 30 of Malik disclose that a current method employed by spammers is to use a different IP address in case their current one gets blocked. This is seen to be implementing the same idea as the applicant's invention. The first computer exists to take care of compliant e-mail and the second computer exists to send out e-mail that is not compliant. Similarly Malik describes a system where a spammer will mail out from one IP until that IP is blocked and then begin to mail from another IP. The essential thing being that when the circumstances change they both change IP's to circumvent the current problem)

Examiner recites the same rationale to combine used in claim 22.

***Conclusion***

53. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN S. MAI whose telephone number is (571)270-5001. The examiner can normally be reached on Monday through Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. S. M./  
Examiner, Art Unit 2456

/Kevin Bates/  
Primary Examiner, Art Unit 2456